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WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/604,898

Applicant(s)
Walker et al.

Examiner
John Young

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3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 28, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-162 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-162 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other: _____

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2 Claims 1-20, 23, 25, 27, 29-33, 35-48, 50, 52, 54, 56-65, 68, 73-116 & 120-138 are rejected under 35 U.S.C. 101, because the claims are directed to non-statutory subject matter.

As per independent claim 1, as drafted the claim is not limited by language to a useful, concrete and tangible application within the technological arts. Claim 1 suffers from undue-breadth.

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It is well settled in the law that “Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which applicants regard as their invention. . . . a rejection under 35 U.S.C. 112, second paragraph would be appropriate. . . . If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate.” (See MPEP 2173.04 Breadth Is Not Indefiniteness (August 2001) p. 2100-195).

Furthermore, it is well settled in the law that “[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims.” (See MPEP 2173.05(q)).

Also, it is well settled in the law that “A process that merely manipulates an abstract idea . . . is nonstatutory despite the fact that it might inherently have some usefulness. See *Alappat*, 33, F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). In this case, claim 1 is drafted so broadly that it is merely a method of “conducting a promotion . . . generating an outcome . . . and providing an indication of a benefit. . . .” offering a television at a discounted price to a consumer. . . .” which all can be done as claimed in such a broad sense with pencil and

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paper (i.e., not within the technological arts).

Claims 2-20, 23, 25, 27, 29-33. 35-48, 50, 52, 54, 56-65, 68, 73-116 & 120-138
are rejected for substantially the same reason as claim 1.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not
identically disclosed or described as set forth in section 102 of this title, if
the differences between the subject matter sought to be patented and the
prior art are such that the subject matter as a whole would have been
obvious at the time the invention was made to a person having ordinary
skill in the art to which said subject matter pertains. Patentability shall not
be negated by the manner in which the invention was made.

3. Claims 1-162 are rejected under 35 U.S.C. §103(a) as being unpatentable over Small
5,791,991; class 463/41, (8/11/98) [US f/d: 11/15/1995] (herein referred to as “Small”).

As per claim 1, Small ([original uncorrected figures] FIG. 2; FIG. 3; FIG. 4; and
FIG. 1) shows “a method for conducting a promotion . . . generating an outcome . . .

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providing an indication of said outcome; and providing an indication of a benefit associated with said outcome.”

Small ([original uncorrected figure] FIG. 4) shows “generating an unlock code capable of unlocking said outcome . . . [and] providing an indication of said unlock code. . . .” In this case, the Examiner interprets the disclosure in [original uncorrected figure] FIG. 4, i.e., the numbers and categories (i.e., “6 CEREALS”; “18 LIGHT BULBS;”; “11 DETERGENTS. . . .”; and “5 CAT FOOD”) as showing “generating an unlock code capable of unlocking said outcome . . . [and] providing an indication of said unlock code. . . .”

Small lacks explicit disclosure of “generating an unlock code capable of unlocking said outcome . . . [and] providing an indication of said unlock code. . . .”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that Small ([original uncorrected figure] FIG. 4) would have been selected in accordance with showing “generating an unlock code capable of unlocking said outcome . . . [and] providing an indication of said unlock code. . . .” because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

As per claims 2-86, Small shows the method of claim 1 and subsequent base claims depending from 1.

Small ([original uncorrected figures] FIG. 1 through FIG. 8; col. 1, ll. 5-67; col. 2,

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ll. 1-56; col. 2, ll. 59-67; col. 3, ll. 1-50; col. 3, ll. 53-67; col. 4, ll. 1-25; col. 4, ll. 58-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-20; and whole document) reasonably suggests the elements and limitations of claims 2-86.

Small lacks explicit recitation of some of the elements of claims 2-86, even though Small reasonable suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-86 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-86, because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

As per claim 87, Small ([original uncorrected figures] FIG. 2; FIG. 3; FIG. 4; and FIG. 1) shows “a method for conducting a promotion, implemented in a promotion control system . . . providing data representative of an outcome . . . providing data representative of a benefit associated with said outcome. . . .”

Small (FIG. 8) shows “receiving data representative of a redemption request associated with said outcome . . . [and] receiving said data representative of said redemption request. . . .”

Small ([original uncorrected figure] FIG. 4) shows “said outcome associated with at least one unlock code . . . [and] providing data representative of sat at least one unlock

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code. . . .” In this case, the Examiner interprets the disclosure in [original uncorrected figure] FIG. 4, i.e., the numbers and categories (i.e., “6 CEREALS”; “18 LIGHT BULBS;”; “11 DETERGENTS. . . .”; and “5 CAT FOOD”) as showing “said outcome associated with at least one unlock code . . . [and] providing data representative of sat at least one unlock code. . . .”

Small lacks explicit disclosure of “said outcome associated with at least one unlock code . . . [and] providing data representative of sat at least one unlock code. . . .” even though Small reasonably suggests same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that Small ([original uncorrected figure] FIG. 4) would have been selected in accordance with showing “said outcome associated with at least one unlock code . . . [and] providing data representative of sat at least one unlock code. . . .” because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

Independent claim 88 is rejected for substantially the same reasons as independent claim 87.

As per claims 89-90, Small shows the method of claim 88 and subsequent base claims depending from 88.

Small ([original uncorrected figures] FIG. 1 through FIG. 8; col. 1, ll. 5-67; col. 2,

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ll. 1-56; col. 2, ll. 59-67; col. 3, ll. 1-50; col. 3, ll. 53-67; col. 4, ll. 1-25; col. 4, ll. 58-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-20; and whole document) reasonably suggests the elements and limitations of claims 89-90.

Small lacks explicit recitation of some of the elements of claims 89-90, even though Small reasonable suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 89-90 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 89-90, because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

Independent claim 91 is rejected for substantially the same reasons as independent claim 1.

As per claims 92-98, Small shows the method of claim 91 and subsequent base claims depending from 91.

Small ([original uncorrected figures] FIG. 1 through FIG. 8; col. 1, ll. 5-67; col. 2, ll. 1-56; col. 2, ll. 59-67; col. 3, ll. 1-50; col. 3, ll. 53-67; col. 4, ll. 1-25; col. 4, ll. 58-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-20; and whole document) reasonably suggests the elements and limitations of claims 92-98.

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Small lacks explicit recitation of some of the elements of claims 92-98, even though Small reasonable suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 92-98 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 92-98, because such selection would have provided *“a more desirable and convenient method of promoting the sale of consumer products. . . .”* (see Small col. 2, ll. 37-42).

Independent claim 99 is rejected for substantially the same reasons as independent claim 87.

As per claims 100-101, Small shows the method of claim 99 and subsequent base claims depending from 99.

Small ([original uncorrected figures] FIG. 1 through FIG. 8; col. 1, ll. 5-67; col. 2, ll. 1-56; col. 2, ll. 59-67; col. 3, ll. 1-50; col. 3, ll. 53-67; col. 4, ll. 1-25; col. 4, ll. 58-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-20; and whole document) reasonably suggests the elements and limitations of claims 100-101.

Small lacks explicit recitation of some of the elements of claims 100-101, even though Small reasonable suggests same.

Official Notice is taken that both the concepts and the advantages of the elements

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and limitations of claims 100-101 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 100-101, because such selection would have provided *"a more desirable and convenient method of promoting the sale of consumer products. . . ."* (see Small col. 2, ll. 37-42).

Independent claim 102 is rejected for substantially the same reasons as independent claim 87.

As per claims 103-104, Small shows the method of claim 102 and subsequent base claims depending from 102.

Small ([original uncorrected figures] FIG. 1 through FIG. 8; col. 1, ll. 5-67; col. 2, ll. 1-56; col. 2, ll. 59-67; col. 3, ll. 1-50; col. 3, ll. 53-67; col. 4, ll. 1-25; col. 4, ll. 58-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-20; and whole document) reasonably suggests the elements and limitations of claims 103-104.

Small lacks explicit recitation of some of the elements of claims 103-104, even though Small reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 103-104 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 103-104,

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because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

Independent claim 105 is rejected for substantially the same reasons as independent claim 1.

As per claims 106-122, Small shows the method of claim 105 and subsequent base claims depending from 105.

Small ([original uncorrected figures] FIG. 1 through FIG. 8; col. 1, ll. 5-67; col. 2, ll. 1-56; col. 2, ll. 59-67; col. 3, ll. 1-50; col. 3, ll. 53-67; col. 4, ll. 1-25; col. 4, ll. 58-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-20; and whole document) reasonably suggests the elements and limitations of claims 106-122.

Small lacks explicit recitation of some of the elements of claims 106-122, even though Small reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 106-122 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 106-122, because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

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Independent claim 123 is rejected for substantially the same reasons as independent claim 1.

Independent claim 124 is rejected for substantially the same reasons as independent claim 1.

Independent claim 125 is rejected for substantially the same reasons as independent claim 1.

Independent claim 126 is rejected for substantially the same reasons as independent claim 1.

As per claims 127-130, Small shows the method of claim 126 and subsequent base claims depending from 126.

Small ([original uncorrected figures] FIG. 1 through FIG. 8; col. 1, ll. 5-67; col. 2, ll. 1-56; col. 2, ll. 59-67; col. 3, ll. 1-50; col. 3, ll. 53-67; col. 4, ll. 1-25; col. 4, ll. 58-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-20; and whole document) reasonably suggests the elements and limitations of claims 127-130.

Small lacks explicit recitation of some of the elements of claims 127-130, even though Small reasonable suggests same.

Official Notice is taken that both the concepts and the advantages of the elements

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and limitations of claims 127-130 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 127-130, because such selection would have provided *“a more desirable and convenient method of promoting the sale of consumer products. . . .”* (see Small col. 2, ll. 37-42).

Independent claim 131 is rejected for substantially the same reasons as independent claim 1.

As per claims 132-133, Small shows the method of claim 131 and subsequent base claims depending from 131.

Small ([original uncorrected figures] FIG. 1 through FIG. 8; col. 1, ll. 5-67; col. 2, ll. 1-56; col. 2, ll. 59-67; col. 3, ll. 1-50; col. 3, ll. 53-67; col. 4, ll. 1-25; col. 4, ll. 58-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-20; and whole document) reasonably suggests the elements and limitations of claims 132-133.

Small lacks explicit recitation of some of the elements of claims 132-133, even though Small reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 132-133 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 132-133,

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because such selection would have provided “*a more desirable and convenient method of promoting the sale of consumer products. . . .*” (see Small col. 2, ll. 37-42).

Independent claim 134 is rejected for substantially the same reasons as independent claim 1.

Independent claim 135 is rejected for substantially the same reasons as independent claim 1.

Independent claim 136 is rejected for substantially the same reasons as independent claim 1.

Independent claim 137 is rejected for substantially the same reasons as independent claim 1.

Independent claim 138 is rejected for substantially the same reasons as independent claim 1.

Independent claim 139 is rejected for substantially the same reasons as independent claim 1.

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Independent claim 140 is rejected for substantially the same reasons as independent claim 1.

Independent claim 141 is rejected for substantially the same reasons as independent claim 1.

Independent claim 142 is rejected for substantially the same reasons as independent claim 1.

Independent claim 143 is rejected for substantially the same reasons as independent claim 87.

Independent claim 144 is rejected for substantially the same reasons as independent claim 87.

Independent claim 145 is rejected for substantially the same reasons as independent claim 87.

Independent claim 146 is rejected for substantially the same reasons as independent claim 87.

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Independent claim 147 is rejected for substantially the same reasons as independent claim 1.

Independent claim 148 is rejected for substantially the same reasons as independent claim 1.

Independent claim 149 is rejected for substantially the same reasons as independent claim 1.

Independent claim 150 is rejected for substantially the same reasons as independent claim 1.

Independent claim 151 is rejected for substantially the same reasons as independent claim 1.

Independent claim 152 is rejected for substantially the same reasons as independent claim 1.

Independent claim 153 is rejected for substantially the same reasons as independent claim 1.

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Independent claim 154 is rejected for substantially the same reasons as independent claim 1.

Independent claim 155 is rejected for substantially the same reasons as independent claim 1.

Independent claim 156 is rejected for substantially the same reasons as independent claim 1.

Independent claim 157 is rejected for substantially the same reasons as independent claim 1.

Independent claim 158 is rejected for substantially the same reasons as independent claim 1.

Independent claim 159 is rejected for substantially the same reasons as independent claim 1.

Independent claim 160 is rejected for substantially the same reasons as independent claim 1.

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Independent claim 161 is rejected for substantially the same reasons as independent claim 1.

Independent claim 162 is rejected for substantially the same reasons as independent claim 1.

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

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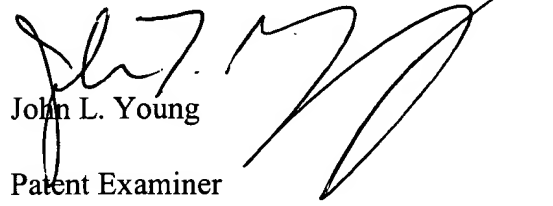
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The

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examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

Patent Examiner

August 6, 2003